



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|------------------------|---------------------|------------------|
| 10/570,048 | 12/12/2006 | Martin David Bloomberg | 1879-12/AMK | 4885 |

7590
Adrian M Kaplan
Dimock Stratton
Suite 3202 Box 102
20 Queen Street West
Toronto Ontario, M5H 3R3
CANADA

12/17/2008

| |
|----------|
| EXAMINER |
|----------|

LUDLOW, JAN M

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1797

| | |
|-----------|---------------|
| MAIL DATE | DELIVERY MODE |
|-----------|---------------|

12/17/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/570,048 | Applicant(s) BLOOMBERG ET AL. | |
| | Examiner Jan M. Ludlow | Art Unit 1797 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>5/30/2006</u> . | 6) <input type="checkbox"/> Other: ____. |

Art Unit: 1797

1. Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

2. Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

While there is a vague description of extracting grape skins with water, steeping to ferment residual sugar, and evaporation to concentrate and remove alcohol, there is no description of how much water is used, what type of grapes, what mass of grape skins, time and temperature of steeping, resulting volume of extract after evaporation, etc. Therefore, there is not an enabling description of how to make the extract. In particular, claim 5 is not enabled because there is no way of determining what 10-25% of pH indicator means, since there is no way to reproduce the extraction process. There is no description at all of the extraction of lichen or cabbage, so there is no enabling description of how to make the cabbage or lichen extract pH indicator.

3. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1797

In that there is no description of how the indicator is extracted, it is not clear what “a concentration of about 10 to about 25%” means within the concentrate. For example adding 1 part indicator extract having 1 M active ingredient to 9 parts water (about 10%) results in the same composition as adding 5 parts indicator having 0.2 M active ingredient to 5 parts water (about 50%).

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

Art Unit: 1797

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Lopes Terci et al (Quimica Nova, vol. 4, no. 4, July 2002).

Lopes Terci teaches an extract of grape fruit or skin used as a pH indicator (Abstract, Figure 6, Table 3). Note on page 9, paragraph 3, it is indicated that “uva” corresponds to *Vitis vinifera*, which is grape. It is the examiner’s position that the solutions shown in Figure 6 contain the indicator and a pH modifying agent, which results in the differences of pH shown, inherently satisfying claims 2-5, to the extent that claim 5 is definite. Note that at pH 4-6, the grape indicator is one color, but different colors above and below, as shown in Table 3. Note that in claim 1, “for use in a concentrate for preparing an agricultural compound” is a statement of intended use, and a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Further, the recitation has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the

Art Unit: 1797

purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Note that in claim 2, "which concentrate can be diluted....acceptable agricultural activity at a pH within the range of 4-6," is a statement of intended use, and a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

9. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Freadman (6589761).

Freadman teaches red cabbage and grape pH indicators. See col. 8, lines 49 and 59.

10. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Azar et al (2001/0012636).

Azar teaches pH indicators extracted from lichens [0082] or cabbage [0083, 0129, 0148]. Note that Azar teaches that the common pH indicator, litmus, is extracted from lichen.

11. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher (5278132) in view of Freadman and Lopes Terci.

Art Unit: 1797

Fisher teaches a concentrate having a pH modifying agent and pH indicator, the concentrate having the instant properties, including pH 4-6 indication (col. 4, line 37). Suitable indicators are methyl red, resorcin blue, 2,5-diphenol and chlorophenol red (col. 3, lines 30-32).

Fisher fails to teach a naturally occurring pH indicator.

Freadman teaches that a natural food or plant pH indicator from red cabbage or grapes can be used as an alternative to methyl red, resorcin blue, 2,5-Diphenol and chlorophenol red (col. 4, line 61, col. 5, line 30, col. 6, lines 9 and 67, col. 8, lines 49-59), and Lopes Terci teaches that grape extract indicator is useful for indicating changes in pH above and below pH 4-6 (Table 3).

It would have been obvious to use a grape extract indicator in the invention of Fisher because it is an alternative to the indicators of Fisher as taught by Freadman, operative in the desired pH range of Fisher as taught by Lopes Terci. With respect to claim 5, to the extent that it is definite, it would have been obvious to optimize the amount of indicator in order to attain the coloration properties taught by Fisher.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan M. Ludlow whose telephone number is (571) 272-1260. The examiner can normally be reached on Monday, Tuesday and Thursday, 11:30 am - 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1797

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jan M. Ludlow
Primary Examiner
Art Unit 1797

/Jan M. Ludlow/
Primary Examiner, Art Unit 1797